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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,079	03/23/2007	John Joseph MacCarron	7733P010	8073

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EXAMINER

LONG, ROBERT FRANKLIN

ART UNIT	PAPER NUMBER
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3764

MAIL DATE	DELIVERY MODE
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01/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,079	Applicant(s) MACCARRON, JOHN JOSEPH	
	Examiner Robert F. Long	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 6-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/27/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 10/09/08 has been entered. Claims 1-18 are pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-5** are rejected under 35 U.S.C. 102(b) as being anticipated by **Wilson (US 5749811 A)**.

Regarding claims 1-5, Wilson discloses a pair of foot bindings about an axis on a pivoting mount assembly in which is attached to a pivot member and an adjustment means for the spacing of the foot bindings, *support frame is flexibly mounted on a floor frame, and the support frame includes a pivot around which the track is rotatable, (column 1, lines 50-55) and rubber mounts 50, FIG. 7, on top of the floor frame 1; a transverse track 20 pivotally supported at the rear of the center frame 10 so as to pivot around a generally vertical, forwardly inclined, axis; and two foot platforms 30A, 30B each pivotally supported on slidable track cars 40A, 40B, FIG. 13, which independently and freely move laterally along the transverse track 20, (column 3, lines 64-67, column 4, lines 1-16).*

Wilson also discloses pivotal foot supports, *foot platforms 30A, 30B each include: (a) a pivoting foot support surface 31 having a toe hold 32 mounted on the forward side*

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thereof for receiving the tip of one's foot or shoe; (b) upstanding medial and lateral side foot support flanges 33, 33', respectively; and (c) upstanding toe and heel plates 34, 34', respectively. As illustrated, the toe and heel plates 34, 34' are pivotally supported near their upper ends to a foot platform support bracket 35 via pivots 37 so as to rotate around the generally horizontal axis Z, FIG. 5. The horizontal pivot 37 for the platform is located above the foot platform to provide greater initial stability, (column 5, lines 19-53).

Regarding claims 16-18, The method discussed here requires all the elements claimed in the prior claims 1-15 and are also obvious steps necessary for using the apparatus for the desired simulated board sport exercise with foot bindings. Wislon also discloses a similar method for using a board with foot binds (*column 11, lines 51-67 and see Abstract*)

Further, It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure, *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Thus, the methods discussed with the apparatus would be obvious to the exercise artisan in order to use the machine in the proper manner for the desired exercise and/or therapy. Also, in order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of functional language, *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Allowable Subject Matter

4. Claims 6-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection of newly cited art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Sano; Takashi (US 6022272 A), Laconis; Gregory E.(US 5941800 A), and Little; Oscar L. (US 5520598 A) and Zejdlik; Donald A. et al. (US 7267346 B2).**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert F. Long whose telephone number is (571)270-3864. The examiner can normally be reached on 5-4-9 (7:30-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on (571) 272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert F Long/
Examiner, Art Unit 3764

/Fenn C Mathew/
Primary Examiner, Art Unit 3764